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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,744	08/18/2000	Brian F. Tack	IOWA:026US	7819

7590 08/26/2003  
Stephen M. Hash  
FULBRIGHT & JAWORSKI L.L.P.  
Suite 2400  
600 Congress Avenue  
Austin, TX 78701

EXAMINER

SHAHNAN SHAH, KHATOL S

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 08/26/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/642,744

Applicant(s)

TACK ET AL.

Examiner

Khatol S Shahnan-Shah

Art Unit

1645

--Th MAILING DATE of this communication appears on th cover sheet with th c rr spond nc address --

THE REPLY FILED 31 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 31 July 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1 and 3.

Claim(s) withdrawn from consideration: 2 and 4-31.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

***Attachment to Advisory Action***

1. Applicants' notice of appeal, received July 31, 2003, paper # 21 is acknowledged.
2. Applicants' amendment C and Reply to a final office action under 37 CFR 1.116, received July 31, 2003, paper # 22 is acknowledged.

The proposed amendments will not be entered because they raise new issues that would require further consideration and/or search for the following reasons:

The proposed amended claims 1 and 3 require new rejection because of the added new limitation "antimicrobial peptide of 12-37 residues".

Amended claims 1 and 3 now raise new matter because claims now include the newly added limitation "antimicrobial peptide of 12-37 residues". However, there appears to be no descriptive support in the instant specification for this added limitation. 37 CFR 1.121 requires that an amendment to the claim must have antecedent basis in the original disclosure. Therefore the new limitation in the claim is considered new matter. *In re Rasussen*, 650 F.2d 1212 (CCPA, 1981). New matter includes not only the addition of wholly unsupported subject matter but also, adding specific percentages or compounds after a broader original disclosure, or even omission of a step or a compound from a disclosure. See MPEP 608.04.

3. Applicants' declaration under 37 CFR 1.132, received July 31, 2003, paper # 23 is acknowledged. The affidavit of Dr. Andrew D. Robertson has been entered and considered but does not overcome the rejection because while the specification discloses a family of antibacterial peptides, does not disclose peptides which range in size from 12-37 residues in length. The sequences of peptides recited by the specification and sequence listing are SEQ ID NOS: 1- 28 which range in size from 14-37 residues.

Art Unit: 1645

*Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khatol Shahnan-Shah whose telephone number is (703) 308-8896. The examiner can normally be reached from 7:30 AM - 4 PM on Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned to is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Khatol Shahnan-Shah, BS, Pharm, MS



Biotechnology Patent Examiner

Art Unit 1645

August 25, 2003

  
RODNEY P SWARTZ, PH.D  
PRIMARY EXAMINER